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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,562	02/18/2004	Zhong Zhao	GPT-032.01	9291
29755	7590	03/26/2008		
FOLEY HOAG, LLP PATENT GROUP (w/GPT) 155 SEAPORT BOULEVARD BOSTON, MA 02110-2600			EXAMINER FUBARA, BLESSING M	
			ART UNIT	PAPER NUMBER
			1618	
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			03/26/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/781,562

Applicant(s)

ZHAO ET AL.

Examiner

BLESSING M. FUBARA

Art Unit

1618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 December 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) 1-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date: _____

DETAILED ACTION

The examiner acknowledges receipt of response to restriction requirement filed 12/26/07; IDS filed 7/22/04 and preliminary amendment filed 03/08/04. Claims 1-48 are pending.

Election/Restrictions

1. Applicant's election with traverse of Group II, claims 35-48 in the reply filed on 12/26/07 is acknowledged. The traversal is on the ground(s) that there is no undue burden to search the inventions of both Groups I and II. This is not found persuasive because there is tremendous burden on the examiner to search the claims 1-34 of Group I having various permutations of the polymers represented by the varied monomeric units of claims 1, 17, 21-24 and 27 and Group II.

The requirement is still deemed proper and is therefore made FINAL.

Thus claims 1-34 are withdrawn from consideration

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 48 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating cancer, does not reasonably provide enablement for treating all diseases. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. This is scope of enablement.

5. Claim 48 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for treating specific disease conditions, does not reasonably provide enablement for preventing all diseases. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. This is scope of enablement.

Enablement is considered in view of the Wands factors (MPEP 2164.01(a)). The court in Wands states: "Enablement is not precluded by the necessity for some experimentation such as routine screening. However, experimentation needed to practice the invention must not be undue experimentation. The key word is 'undue,' not 'experimentation.'" (*Wands*, 8 USPQ2d 1404). Clearly, enablement of a claimed invention cannot be predicated on the basis of quantity of experimentation required to make or use the invention. "Whether undue experimentation is needed is not a single, simple factual determination, but rather is a conclusion reached by weighing many factual considerations." (*Wands*, 8 USPQ2d 1404). The factors to be considered in determining whether undue experimentation is required include: (1) the quantity of experimentation necessary, (2) the amount or direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims. While all of these factors are considered, a sufficient number of the above factors are considered below for a *prima facie* case.

1) Nature of the invention.

The nature of the invention administering a composition comprising polyphosphate ester to treat or prevent any disease condition.

2) State of the prior art and the predictability or lack thereof in the art.

The state of the prior art involves screening *in vitro* and *in vivo* to determine which compounds exhibited the desired pharmacological activities (i.e. what compounds can treat which specific disease). There is no predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face. The instant claimed invention is highly unpredictable as discussed below:

It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. *In re Fisher*, 427 F.2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. Further, their mode of action is often unknown or very unpredictable and administration of the drugs can be accompanied by undesirable side effects.

3) Quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The quantity of experimentation needed is undue experimentation. One of ordinary skill in the art would first need to determine with some degree of certainty the absence or presence of any disease and how to determine that a subject who has no determined predisposition to having any diseases would not ever have that condition by administration of the instant composition or that all of the test subjects that have been determined to have no predisposition to any disease.

4) Level of predictability in the art.

The art pertaining to prevention or treating of any disease condition remain highly unpredictable. As disclosed above, it is not predictable even in view of the seemingly high level of skill in the art. Firstly, there is no composition that has been shown to be effective in

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stopping any disease condition. There is a vast range of forms that it can take, causes for the problem, and biochemical pathways that mediate the disease condition may take. There is no common mechanism by which all, or most diseases arise.

5) Amount of direction and guidance provided by the inventor.

The amount of direction or guidance present is drawn to treating conditions related cancer and even the treatment of cancer encompasses a wide array of various cancer and cell proliferation.

6) Breadth of claims.

The claims are extremely broad due to the vast number of possible compositions recited by the instant invention and conditions that are treatable with the composition.

It is noted that the specification must teach those of skill in the art how to make and how to use the invention as broadly claimed. In re Goodman, 29 USPQ2d at 2013 (Fed. Cir. 1994), citing In re Vaeck, 20 USPQ2d at 1445 (Fed. Cir. 1991). The courts have stated that reasonable correlation must exist between scope of exclusive right to patent application and scope of enablement set forth in patent application. 27 USPQ2d 1662 *Ex parte Maizel*.

Scope of Enablement is considered in view of the Wands factors (MPEP 2164.01 (a)). In view of the quantity of experimentation necessary to determine the parameters listed above, the lack of direction or guidance provided by the specification, the absence of working examples for the demonstration or correlation to preventing cells from proliferating.

6. Claim 48 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The boundaries for the protection sought for disease and prevention are not discernible making the scope of the claims unclear and indefinite.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 35-48 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnette et al. (WO 02/04544).

Barnette discloses method of making polyphosphoester and polyphosphoester (claims 1, 6-10, 15-19, 22-27, 33, 35-38, 42, 43, 47 and 68); the polyphosphoester is biodegradable (page 4, lines 21-24) with the biodegradable term also meaning bioerodible (page 5, lines 16). Although claims 44 and 45 recite the properties of the composition, the disclosure of Barnette indicating biodegradability of the polyphosphoester further meets those claims. In certain embodiments, these polymers have associated therapeutic agents (page 5, lines 17-26) and are useful for in vivo therapy (page 4, lines 24-31) meeting claims 46-48. The polyphosphoesters comprise lactides and other groups containing aryl, cycloalkyl and alkyl groups (pages 7-9).

9. Claims 35-39 and 43-45 are rejected under 35 U.S.C. 102(b) as being anticipated by Werner et al., submitted by applicant on form 1449).

Werner discloses polyphosphoester that is comprised of glycolic esters of phosphonic acid and the side chain groups are alkyl, cycloalkyl aryl, aralkyl and alkylaryl (column 1, lines 38-55; column 2, lines 5-40) thereby meeting the claims.

Double Patenting

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 35-45 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 6-11, 13-19, 21-25, 33, 35-38, 43, 47, 66, 70 and 73 of U.S. Patent No. 6,455,665. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim not is patentably distinct from the reference claim(s) because the examined claim is either anticipated, or would have been obvious, over the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). In this case, the issued claims prepare the composition of the examined claims.

12. No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to BLESSING M. FUBARA whose telephone number is (571)272-0594. The examiner can normally be reached on 7 a.m. to 5:30 p.m. (Monday to Thursday).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Hartley can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Blessing M. Fubara/
Examiner, Art Unit 1618